



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/623,588
Applicant : Gary Schlatter
Filed : 07/22/2003
Group Art Unit: 3781
Examiner : Smalley
Docket No. : ORA-005
Customer No. : 021884
Title : DISPENSING CONTAINER

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Sir:

REAL PARTY IN INTEREST

Gary Schlatter is the real party in interest in the above referenced patent application.

RELATED APPEALS AND INTERFERENCES

Neither Appellant's representative nor Appellant is aware of any related appeals and/or interferences affected by or having a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-20 are currently pending and stand finally rejected. Appellant accordingly appeals the Examiner's final rejection of claims 1-20.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Rejection. As to the amendments filed prior to the Final Rejection, all amendments appear to have been entered and considered.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Claims 1, 8 and 16 are the only independent claims involved in the present Appeal. These claims are summarized below.

In independent claim 1, Appellant has claimed a dispensing container 10 with a selectively removable cap 12 to which a variety of articles may be securely and selectively attached. The dispensing container 10 has a dispensing body 14 in which material 18 for dispensing is stored. The dispensing body 14 has a closed end 24, a side wall 26, an open end 22 through which the material 18 is dispensed and a cap 12 shaped and dimensioned for selectively covering the open end 22 of the dispensing body 14. The cap 12 has a first end 28 shaped and dimensioned for engaging the open end 22 of the dispensing body 14 for secure and selective attachment thereto and a closed second end 30 with a clasp 32 extending therefrom. The clasp has a first arm 48 and a second arm 50. The first arm 48 has a first arcuate member 52 and a first upwardly extending connecting member 54 linking the first arcuate member 52 to the cap 12. The second arm 50 has a second arcuate member 56 and a second upwardly extending connecting member 58 linking the second arcuate member 56 to the cap 12. The first arm 48 and the second arm 50 are oriented upon the cap so as to overlap in a mating configuration with the first arm 48 lying over the second arm 50. Further, the first arcuate member 52 and the second arcuate member 54 overlap through a substantial portion of their respective arcs. (Specification Pages 5-7)

In independent claim 8, Appellant claims a dispensing container 10 with a selectively removable cap 12 to which a variety of articles may be securely and selectively attached. The dispensing container 10 has a dispensing body 14 in which material 18 for dispensing is stored. The dispensing body 14 has a closed end 24, a side wall 26, an open end 22 through which the material 18 is dispensed and a cap 12 shaped and dimensioned for selectively covering the open end 22 of the

dispensing body 14. The cap 12 has a first end 28 shaped and dimensioned for engaging the open end 22 of the dispensing body 14 for secure and selective attachment thereto and a closed second end 30 with a clasp 32 extending therefrom. The clasp has a first arm 48 and a second arm 50. The first arm 48 has a first arcuate member 52 extending along an arc of at least 120 degrees and a first upwardly extending connecting member 54 linking the first arcuate member 48 to the cap, and the second arm 50 has a second arcuate member 56 extending along an arc of at least 120 degrees and a second upwardly extending connecting member 58 linking the second arcuate member 56 to the cap 12. The first arm 48 and the second arm 50 are oriented upon the cap 12 so as to overlap in a mating configuration with the first arm 48 lying over the second arm 50. Further, the first arcuate member 52 and the second arcuate member 54 overlap through at least a 60 degree arc. (Specification Pages 5-8)

In independent claim 16, Appellant claims a cap 12 to which a variety of articles may be securely and selectively attached. The cap 12 is adapted for use in conjunction with a dispensing body 14 in which material 18 for dispensing is stored. The dispensing body 14 has a closed end 24, a side wall 26, and an open end 22 through which the material 18 is dispensed. The cap 12 is shaped and dimensioned for selectively covering the open end 22 of the dispensing body 14. The cap 12 has a first end 28 shaped and dimensioned for engaging the open end 22 of the dispensing body 14 for secure and selective attachment thereto and a closed second end 30 with a clasp 32 extending therefrom. The clasp 32 has a first arm 48 and a second arm 50. The first arm 48 has a first arcuate member 52 and a first upwardly extending connecting member 54 linking the first arcuate member 52 to the cap 12. The second arm 50 has a second arcuate member 56 and a second upwardly extending connecting member 58 linking the second arcuate member 56 to the cap 12. The first arm 48 and the second arm 50 are oriented upon the cap 12 so as to overlap in a mating

configuration with the first arm 48 lying over the second arm 50. Further, the first arcuate member 52 and the second arcuate member 54 overlap through a substantial portion of their respective arcs.

(Specification Pages 5-7)

The dependent claims are not argued separately and are, therefore, not addressed in the Summary.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1-20 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0217139 to Roth et al. (Roth) in view of U.S. Patent No. 5,996,191 to Christler (Christler).

ARGUMENTS

I. CLAIMS 1-20 ARE PATENTABLE OVER ROTH IN VIEW OF CHRISTLER

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roth in view of Christler. With reference to claim 1, Appellant has claimed a dispensing container with a selectively removable cap to which a variety of articles may be securely and selectively attached. The dispensing container has a dispensing body in which material for dispensing is stored. The dispensing body has a closed end, a side wall, an open end through which the material is dispensed and a cap shaped and dimensioned for selectively covering the open end of the dispensing body. The cap has a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end with a clasp extending therefrom. The clasp has a first arm and a second arm. The first arm has a first arcuate member and a first upwardly extending connecting member linking the first arcuate member to the cap. The second arm has a second arcuate member and a second upwardly extending connecting member linking the second arcuate member to the cap. The first arm and the second arm are oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm. Further, the first arcuate member and the second arcuate member overlap through a substantial portion of their respective arcs

The Examiner generally contends that Roth teaches a dispensing container with an integrally formed hook and gate which allows the device to be attached to an object, but the hook and gate do not teach a first arcuate portion and a second arcuate portion which overlap along a substantial portion of their respective arcs. In an attempt to overcome the clear deficiencies in the disclosure of Roth, the Examiner relies upon the teaching of the hookless connecting ring of Christler, arguing

the modification of Roth based upon Christler is motivated by the benefit of providing a resilient closed loop connection equally capable of securing the ring to an object.

In establishing the law governing obviousness-type rejections, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy... This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

With the foregoing in mind, the U.S. Patent & Trademark Office has determined that a *prima facie* case of obviousness is established by meeting three basic criteria. First, the Examiner must show some suggestion or motivation to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success in modifying the primary reference based upon the teachings of the prior art. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Support for the proposed modification and the reasonable expectation of success must be found in the prior art. MPEP 706.02(j).

With this in mind, the Examiner has failed to set forth a *prima facie* case. First, the motivation suggested by the Examiner, that is, creating a benefit of providing a resilient closed loop connection equally capable of securing the ring to an object, is not supported by the cited references.

U.S. Patent Application Publication No. 2004/0217139, to Roth et al., is not itself prior art due to its November 5, 2003 filing date, which is after Appellant's July 22, 2003 filing date. If one is going to rely upon the April 30, 2003 filing date based upon a claim of priority to U.S. Design Patent No. D485,757, then only what is shown in the design patent can be relied upon. This means the total written specification in the '139 published application cannot be relied upon and, at best only, the very upper portion of Figure 1 of the '139 application can be relied upon as this is the only subject matter of the '139 application which finds support in the '757 design patent.

In fact, and considering the '757 design patent is published and available for citation in the prosecution of the present application, the '757 design patent should actually be cited in the outstanding rejection. However, the Examiner would then be left with no written disclosure to rely upon in making a rejection and the rejection would certainly fail. Presumably, this must be why the Examiner chose not to use the '757 design patent in the rejection and apparently cites Roth to take advantage of its written disclosure, which is not prior art and may not be properly used in establishing the present rejection. Neither the Examiner nor the Board is rightfully permitted to look to the written disclosure of Roth in assessing the patentability of the claimed invention as this subject matter is predated by the claimed invention.

Without the benefit of the written disclosure found and the drawings not finding support in the '757 design patent, there is nothing in the supported disclosure of Roth teaching a "hook and gate" as the Examiner contends. The '757 design patent and the upper portion of Figure 1 of Roth make no mention of a hook and gate. In fact, there is nothing which teaches a device or structure used to attach the lid of the '757 design patent to an object. There is also nothing in the design showing a selectively removable cap. Further, there is nothing showing a cap having a first end shaped and dimensioned for engaging an open end of a dispensing body for secure and selective

attachment thereto and a closed second end with a clasp extending therefrom. There is also absolutely no support in the Roth design that the lid for a bottle shown includes a clasp. There is no indication that the structure shown in the design functions to attached to objects. There is further no indication that the structure shown is at all resilient. Contrary to the Examiner's opinion in the Response to Arguments in the Final Office Action, all Roth can be relied upon for showing (that is, based upon the April 30, 2003 filing dated relied upon by the Examiner) is a tear drop shaped loop with a slit. It does not disclose a gap and overlapping gate members as claimed.

Therefore, why would one of skill in the lid art look to Christler for a teaching? Christler is not concerned with lids for bottles. Still further, the structure of Christler is not, nor can it be determined to be, essentially the same as that of Roth. Again, there is no disclosure in Roth teaching resilient distortion. Additionally, the resilient distortion in Christler is not the same as that in Appellant's invention or that contemplated in Roth (that is, if one could rely on the complete specification of Roth, which is not permitted). Christler's arms 14, 16 separate sideways relative to one another. They do not separate up and down relative to each other.

The Examiner has also failed to show a reasonable expectation of success in modifying the primary reference Roth based upon the teachings of the Christler. The Examiner states that Roth is made from a thicker gauge material then the ring of Christler, which again is not supported by the references and is merely made up. However, if Roth is made from a thicker gauge material then how is it possible that it could flex sideways as taught by Christler. As seen in Figure 1 of Christler, a moment arm M_b is created as arms 14 and 16 move in and out of the paper as they are separated. Referring to Figure 2 of Christler, a moment arm M_t is created by moving the arms sideways relative to each other. Thus, the proposed modification shows no reasonable expectation of success.

Quite simply there is no motivation to combine these references and, even if combined, how Appellant's claimed invention results.

In independent claim 8, Appellant has specifically claimed the first arm includes a first arcuate member extending along an arc of at least 120 degrees and a first upwardly extending connecting member linking the first arcuate member to the cap. The second arm includes a second arcuate member extending along an arc of at least 120 degrees and a second upwardly extending connecting member linking the second arcuate member to the cap. The first arm and the second arm are oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through at least a 60 degree arc.

The Examiner somehow addresses these limitations by an assumption as to the size of Christler and the desire to fabricate a rejection. The overlap in Christler is certainly not 60 degrees and there is no overlap in Roth. So, how is it taught by the references that when combined a 60 degree overlap is the result?

The arguments presented above generally deal with the "pre-KSR world". In view of the new "Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*", Appellant has attempted to address various issues that may not have been contemplated by the Examiner prior to the rendering of a decision in KSR. In particular, the Examination Guidelines set forth various proposed rationales for articulating why a claimed invention would in fact be obvious. After reviewing the proposed rationales and considering the rejection in the outstanding application, it is quite possible one might attempt to apply the following rationales in supporting or explaining the rationale for obviousness in the present application; (1) applying a known technique to a known device ready for improvement

to yield predictable results; (2) known work in one field of endeavor may prompt variation of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; or (3) some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

With regard to the first rationale listed above, that is, applying a known technique to a known device, the Examination Guidelines indicate that an Examiner must first provide a finding that the prior art contains a base device upon which the claimed invention can be seen as an improvement. Presumably, the base device would be that disclosed by Roth in Design Patent No. D485,757, as that is all that can be relied upon from the Roth '139 published application. Thereafter, the Examiner must present a finding that the prior art contained a known technique that is applicable to the base device. Presumably, the Examiner would argue this is taught by Christler. Finally, the Examiner must present a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system. This is where the Examiner would certainly fail to find support for the factual inquiry required under *KSR*. In particular, and as fully discussed above, Roth fails to teach a resilient clasp and Christler fails to teach a resilient clasp on a cap as claimed. Christler merely teaches a hookless locking ring. With this in mind, why would the claimed invention be a predictable modification of the cited references? What is truly the predictability of adding a hookless locking ring to a dispensing cap and resulting in the claimed invention?

As to the second rationale for obviousness, that is, that known work in one field of endeavor may prompt variation of it for use in either the same field or a different one based on design incentives or other market forces, this rationale first requires that the scope and content of the prior

art, whether in the same field of endeavor as that of Appellant's invention or a different field of endeavor, included a similar analogous device. Presumably, the scope and content of the prior art would include the disclosures of Roth and Christler. Thereafter, the Examiner must provide a finding that there were design incentives or market forces which would have prompted adaptation of the known device. At the current time, and absent the disclosure of the present application, there are no design incentives or market forces which would have prompted one to modify either Roth or Christler so as to read upon the pending claims. Further, and even if one were able to find such incentives, the Examiner must find that the differences between the claimed invention and the prior art were encompassed in known variations or in principles known in the prior art. Once again, Roth and Christler fail to provide support for this required finding, as what Appellant has claimed is not encompassed in these references.

Finally, and with regard to the third rationale, that is, that some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention, the Examiner would once again fail to find a sufficient finding of obviousness to support a rejection under 35 U.S.C. § 103 and *KSR*. In particular, this rationale requires that the Examiner present a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Presumably, Roth and Christler are the references and, as discussed above, neither of these references provides any teaching to support the concept that one would desire to provide a clasp as claimed on a dispenser cap.

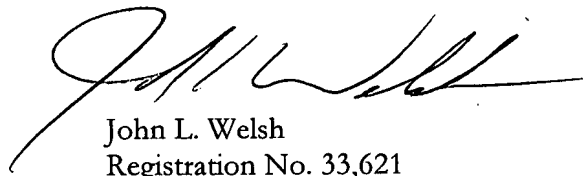
With the foregoing in mind, and considering the new Examination Guidelines recently presented in view of *KSR*, it remains Appellant's opinion the outstanding rejections are improper and Appellant respectfully requests they be reversed.

In view of the above remarks, it is respectfully requested that the rejection of claims 1-20 under Roth in view of Christler be reversed, as this rejection has now been shown to be improper under both *Graham v. John Deere* and *KSR*.

II. CONCLUSION

In conclusion, Appellant has now shown that the references cited by the Examiner neither disclose nor suggest the claimed invention. Therefore, it is respectfully requested that the outstanding rejection of claims 1-20 be reversed.

Respectfully submitted,



John L. Welsh
Registration No. 33,621
Attorney for Appellant

WELSH & FLAXMAN, LLC
2000 Duke Street, Suite 100
Alexandria, VA 22314
(703) 920-1122

CLAIMS APPENDIX

1. A dispensing container including a selectively removable cap to which a variety of articles may be securely and selectively attached, comprising:

a dispensing body in which material for dispensing is stored, the dispensing body including a closed end, at least one side wall and an open end through which the material is dispensed;

a cap shaped and dimensioned for selectively covering the open end of the dispensing body, the cap including a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end including a clasp extending therefrom;

the clasp including a first arm and a second arm, the first arm includes a first arcuate member and a first upwardly extending connecting member linking the first arcuate member to the cap, and the second arm includes a second arcuate member and a second upwardly extending connecting member linking the second arcuate member to the cap; the first arm and the second arm being oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through a substantial portion of their respective arcs.

2. The dispensing container according to claim 1, wherein the first arcuate member has a slightly smaller radius of curvature than the second arcuate member.

3. The dispensing container according to claim 2, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

4. The dispensing container according to claim 3, wherein the first arm includes a first upwardly extending connecting member linking the first arcuate member to the cap and the second arm includes a second upwardly extending connecting member linking the second arcuate member to the cap, and wherein the first upwardly extending connecting member is longer than the second upwardly extending connecting member.

5. The dispensing container according to claim 1, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

6. The dispensing container according to claim 1, wherein the first arm and the second arm are positioned approximately 2 mm or less from one another.

7. The dispensing container according to claim 1, wherein the first arm includes a first upwardly extending connecting member linking the first arcuate member to the cap and the second arm includes a second upwardly extending connecting member linking the second arcuate member to the cap, and wherein the first upwardly extending connecting member is longer than the second upwardly extending connecting member.

8. A dispensing container including a selectively removable cap to which a variety of articles may be securely and selectively attached, comprising: a dispensing body in which material for dispensing is stored, the dispensing body including a closed end, at least one side wall and an open end through which the material is dispensed; a cap shaped and dimensioned for selectively covering the open end of the dispensing body, the cap including a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end including a clasp extending therefrom; the clasp including a first arm and a second arm, the first arm includes a first arcuate member extending along an arc of at least 120 degrees and a first upwardly extending connecting member linking the first arcuate member to the cap, and the second arm includes a second arcuate member extending along an arc of at least 120 degrees and a second upwardly extending connecting member linking the second arcuate member to the cap; the first arm and the second arm being oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through at least a 60 degree arc.

9. The dispensing container according to claim 8, wherein the first arcuate member has slightly smaller radius of curvature than the second arcuate member.

10. The dispensing container according to claim 9, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

11. The dispensing container according to claim 9, wherein the first arm and the second arm are positioned approximately 2 mm or less from one another.

12. The dispensing container according to claim 9, wherein the first upwardly extending connecting member is longer than the second upwardly extending connecting member.
13. The dispensing container according to claim 8, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.
14. The dispensing container according to claim 8, wherein the first upwardly extending connecting member is longer than the second upwardly extending connecting member.
15. The dispensing container according to claim 8, wherein the first arcuate member includes a proximal end connected to the first upwardly extending connecting member and a free distal end and the second arcuate member includes a proximal end connected to the second upwardly extending member and a free distal end, and wherein the distal ends of both the first arcuate member and the second arcuate member are tapered.

16. A cap to which a variety of articles may be securely and selectively attached, the cap being adapted for use in conjunction with a dispensing body in which material for dispensing is stored, the dispensing body including a closed end, at least one side wall and an open end through which the material is dispensed, wherein the cap is shaped and dimensioned for selectively covering the open end of the dispensing body, the cap comprising: a first end shaped and dimensioned for engaging the open end of the dispensing body for secure and selective attachment thereto and a closed second end including a clasp extending therefrom; the clasp including a first arm and a second arm, the first arm includes a first arcuate member and a first upwardly extending connecting member linking the first arcuate member to the cap, and the second arm includes a second arcuate member and a second upwardly extending connecting member linking the second arcuate member to the cap; the first arm and the second arm being oriented upon the cap so as to overlap in a mating configuration with the first arm lying over the second arm, the first arcuate member and the second arcuate member overlapping through a substantial portion of their respective arcs.

17. The cap according to claim 16, wherein the first arcuate member has slightly smaller radius of curvature than the second arcuate member.

18. The cap according to claim 17, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

19. The cap according to claim 16, wherein the first arcuate member extends along an arc which is larger than the arc of the second arcuate member.

20. The cap according to claim 16, wherein the first arm and the second arm are positioned approximately 2 mm or less from one another.

EVIDENCE APPENDIX

Not Applicable

RELATED PROCEEDINGS APPENDIX

Not Applicable